

REMARKS

No claims have been canceled. No claims have been added. Claim 12 has been amended to merely define the invention with more clarity. Accordingly, Applicant asserts that no claims have been narrowed within the meaning of Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., No. 95-1066, 2000 WL 1753646 (Fed. Cir. Nov. 29, 2000). Additionally, Applicant asserts that all amendments are supported by the application-as-filed and that no new matter has been added. Claims 1-30 and 65-75 remain in the application. Reconsideration of the application is requested in light of the foregoing amendments and following remarks.

Applicant acknowledges with thanks the examiner's communication mailed 6/12/02 noting receipt of a sample, apparently from the inventor. Applicant apologizes for any inconvenience caused by such submission.

Rejection of Claims under 35 U.S.C. §103(a)

Claims 1-30 and 65-75 stand rejected under 35 U.S.C. §103 (a) as being unpatentable for obviousness over Varoglu et al (US 5,782,054) in view of Thomas (US 4,845,858). Applicant respectfully traverses the rejection.

Varoglu teaches a rather unconventional structure of dimension lumber in combination with a sheathing layer mounted directly in the interior of the framing wall. This is accomplished by rotating the vertical studs 90 degrees with respect to conventional orientation, thereby making room in the thickness of the framing wall for the ½ inch thickness of the sheathing member. Elongate slots are cut along the lengths of the plate and sill members of the frame wall, to receive and position the ½ inch sheathing member sheet.

Applicant appreciates the examiner's candor in acknowledging at page 2 that Varoglu does not disclose stud locator markings as recited in each of the claims at issue.

The examiner then states that it would have been *obvious to combine Varoglu's lumber construction with using Thomas' stud locating tape*. Applicant traverses, and submits that it would not have been obvious to combine.

While the examiner has asserted the obviousness to combine, the examiner has shown no motivation to combine, other than hindsight reconstruction. The examiner has not referred to any motivation enunciated in any reference. Indeed, even a casual review of the references shows that the tapes of Thomas are printed for studs whose width extends along the width of the wall being framed, while the Varoglu structure requires that the widths of the studs be oriented along a longitudinal length of the wall being framed. Thus, it is clear, from even a casual observation, that the tape of Thomas cannot simply be combined into Varoglu to arrive at an improved product. Thus, there is indeed a negative motivation - to not combine Thomas and Varoglu.

However, since the examiner has asserted that it would have been obvious to combine Varoglu and Thomas, let's take a look at what happens if we make such a combination. Unfortunately, the examiner doesn't tell us much about the combination, so any analysis, to be instructive, will have to consider a number of possibilities and the respective results.

Referring to Thomas at FIGURES 2 and 4, we see that the tape 22 runs the full length of both the top plate and the bottom plate, on the surfaces which face upward and downward. These are the surfaces onto which the vertical studs are to be attached to the top and bottom plates. Accordingly, the thickness of the tape is a factor in both length of the vertical studs, and in the role played by friction in securing the vertical studs in abutting relationship with the top and bottom plates. The tape interferes with direct surface-to-surface contact, whereby the typical role of friction in framing walls is usurped, negated, by use of the tape.

Of the tapes taught in Thomas, only the 1.5 inch tape can be used without interfering with groove 14. Applicant assumes for sake of discussion, that the tape is used on only one side of the groove, since use on both sides would be rather expensive. Indeed, the tape option is unlikely to be cost effective, whereby there would be no motivation to combine because of cost factors.

But, assuming the tape is used on one side of the groove, the tape as illustrated in Thomas, is not properly printed to be used with vertical studs which are oriented with the width of the stud extending the length of the wall. So the Thomas tape, as taught in the reference, is not suitable for use directly with Varoglu. Applicant suspects it will be the examiner's position that it would be obvious to change the Thomas tape to accommodate the studs in Varoglu. Again, applicant traverses.

Certainly, it might have been *obvious to try* a combination of Thomas and Varoglu. It might have been *obvious to try* changing the print pattern on the tape of Thomas. But Thomas provides no insight into patterns not illustrated. It is well established law that *obvious to try* does not suffice to defeat patentability.

Further, looking at all the references of record, not just Thomas and Varoglu, where is the instance of motivation to cause one to obviously select Thomas and Varoglu, and make a combination of these two references, and not another 2 references? Why not combine Thomas with another reference? Why not combine Varoglu with Liang? Certainly Liang provides means to locate the vertical studs. But again not in the orientation desired in Varoglu. So, if Thomas is obvious, why not Liang?

Again, suppose for sake of argument that one does find it obvious to combine Thomas and Varoglu (applicant does not concede such combination as obvious). What does one end up with when the combination is made?

In assessing the result, applicant submits that it is not proper for the examiner to go beyond the four corners of the teaching of the reference. Further, applicant submits that it is not proper for the examiner to assert obvious to combine two references, and then assert further obviousness to make still further changes to the resultant combination of the references. Applicant acknowledges that the examiner can assert certain obvious changes to a reference, or can assert obviousness to combine references where there is proper motivation. However, applicant also submits that it is improper for the examiner to assert multiple levels of obviousness, wherein a second level of asserted obviousness is built on a first level of asserted obviousness. Stated another way, the examiner may not assert an obvious modification of a reference, and then use the modified reference as basis for asserting further "obvious" changes.

Indeed, on its face, what the examiner has done is to assert that it would have been obvious to combine Thomas and Varoglu, and has then asserted that certain modifications to that *obvious* combination would have been obvious. Indeed, the examiner is correct that additional changes would be required in order to arrive at the claimed invention. But such stacking of obviousness assertions is proscribed in the law, and is often seen as hindsight reconstruction.

Turning to the applied references, Thomas suggests that his tape be e.g. 1.5 inches, 3 inches, or 5 inches wide (column 1 line 67). Let's analyze. If the tape is 3 inches wide or 5 inches wide, the tape overlies the groove 14 and interferes with installation of the sheathing. The 3 inch tape and the 5 inch tape won't work. Therefore, it is certainly not obvious to use the 3 or 5 inch tapes.

If the tape is 1.5 inches wide, the tape can in fact be applied on the sill or plate, or both, on one side of groove 14. However, the thickness of the tape does change the effective distance between top and bottom sill and plate. In such instance, if all vertical studs are cut to the same length, the studs on one side of the sheath/sill/plate, fit tighter than on the other side, leading to asymmetric loading of the frame. In order to provide symmetric loading of the frame, the studs on one side must be cut longer/shorter than on the other side. This makes for added complexity of the design. Again an undesirable result, whereby the combination would not be obvious to one of ordinary skill in the art.

What if the tape is applied on both sides of the groove? This does solve the disparate length problem. But Thomas does not teach side-by-side tapes, so such structure is beyond the teaching of the reference, and is not a valid structure for analysis of patentability.

In addition, using two tapes presents a problem of added cost, such that two tapes wouldn't likely be used, anyway. Again, not an obvious solution.

Application on both sides further presents the problem of registering the two tapes with respect to each other. Again, a complexity is added, which would discourage one from using two tapes, whereby the combination would not have been obvious.

Further, the tapes, as taught in Thomas, are improperly marked for the studs as used in Varoglu. Thomas does not cure such improper marking, does not teach generically how to mark for studs rotated 90 degrees to the markings shown. The end result is that the markings of Thomas simply do not work in the structure of Varoglu. Another indicator that the combination of Thomas and Varoglu would not have been obvious to one of ordinary skill in the art.

So far, applicant has argued that the examiner's assertion that it would have been obvious to combine Varoglu and Thomas is defective, that it would not have

been obvious to combine the references. And applicant is firmly of the position that it would not have been obvious to one of ordinary skill in the art to combine Varoglu and Thomas.

But suppose applicant is mistaken? Suppose it is truly obvious to combine the references as asserted by the examiner? Does one then end up with the claimed invention? Applicant submits that the answer is a clear NO.

As implicitly acknowledged by the examiner, all claims require that the marking material be deposited directly on the respective piece of lumber. Applicant submits that the deposit of the marking material directly on the piece of lumber is more than a mere rearrangement of parts. Rather the marking directly on the piece of lumber removes a number of negative factors extant in the tape of Thomas. First, the cost is greatly reduced. Second, the length issues discussed above are avoided. Third, the normal abutting frictional values are preserved. Fourth, any tendency for tape adhesive to slip on the plate, thus to either mis-mark the plate, or to cause movement of the stud during or after assembly is avoided. Fifth, any risk that the tape be removed, e.g. during rough handling, is avoided.

Applicant submits that the above differences arise to much more than mere rearranging of parts. Rather, the invention constitutes various differences, indeed improvements, in function, providing the marking features desired in Thomas while avoided many disadvantages of Thomas.

Accordingly, the differences between the claimed invention and any use of Thomas or combination of Thomas with any other reference, are such as to clearly arise to patentable novelty. Thus, applicant respectfully requests that all rejection on the basis of 35 U.S.C. 103(a) be withdrawn, and all claims be indicated as allowable.

Applicant thus submits that all claims as presented herein are allowable over all references of record. Allowance is respectfully solicited. No fee is believed to be due. Should any fee be properly due, or if any refund is due, kindly charge same, or credit any overpayment, to Deposit Account 23-2130.

Also enclosed here is a Notice of Appeal. Applicant respectfully requests that, in the event the examiner is inclined to further reject, or hold to the rejection of, the application, the enclosed Notice of Appeal be entered.

Please feel free to contact me with any questions, comments or concerns, at the telephone number listed at the end of this document.

SN: 09/535,457

29462

Respectfully submitted,
Fred Christian Baij

By: Thomas D. Wilhelm
Thomas D. Wilhelm
Attorney for Applicant
(Reg. No. 28,794)

Customer Number: 23482

June 19, 2002
100 W. Lawrence Street, Third Floor
Appleton, Wisconsin 54911
920-831-0100
FAX: 920-831-0101

APPENDIX AVERSION WITH MARKINGS TO SHOW CHANGES MADEIn the Claims

Kindly amend Claim 12 as indicated following.

12(Twice Amended). A framing lumber product operative to assist in layout and assembly of a wall wherein such wall comprises a bottom plate and a top plate, and a plurality of dimension studs extending between the bottom plate and the top plate at one or more of a limited number of pre-determined standard stud spacings along the bottom plate and the top plate, said framing lumber product comprising:

- (a) an elongate piece of lumber for use in one of the bottom plate and the top plate, said elongate piece of lumber having first and second ends and a length therebetween, a front surface and a back surface, opposing sides extending between the front and back surfaces along the length thereof, and thickness dimensions between the front surface and the back surface, and between opposing sides thereof; and
- (b) a plurality of stud locator markings spaced along the length of said elongate piece of lumber at one or more surfaces which assist in defining respective ones of the nominal thickness dimensions, each said stud locator marking defining a position for placement, on said elongate piece of lumber, of an end of a stud dimension lumber piece having opposing front and back surfaces and a thickness dimension therebetween, to be joined to said elongate piece of lumber, said marking indicators on said elongate piece of lumber indicating the positions where the front and back surfaces of respective stud lumber pieces are to intersect said elongate piece of lumber;

the plurality of stud locator markings being spaced from each other along the length of said elongate piece of lumber at at least one of the limited number of pre-determined standard stud spacings,

- each of the plurality of stud locator markings comprising marking material deposited directly on said elongate piece of lumber at a such respective surface which assists in defining a such thickness dimension of the respective said elongate piece of lumber .